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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/691,332

10/18/2000

Edward M. Housel

MBHB00-593

5214

7590

09/10/2004

Richard A. Romanchik  
Heidelberg Digital L.L.C  
2600 Manitou Road  
Rochester, NY 14624

EXAMINER

PARK, CHAN S

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/691,332

**Applicant(s)**

HOUSEL, EDWARD M.

**Examiner**

CHAN S PARK

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Information Disclosure Statement*

1. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 4, is attached to the instant Office action.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *post-printing trimming device or the trimming device* disclosed in claims 7, 8, 15 and 16 must be shown. Examiner suggests the applicant to include the device in fig.1. This will not raise a new matter since the device is originally claimed and disclosed in the Specification.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "instruction sheet," in claims 7, 8, 15 and 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

The following quotations of 37 § CFR 1.75(d)(1) is the basis of objection:

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

4. Claims 8 and 16 recite the limitation "the trimming instruction". There is insufficient antecedent basis for this limitation in the claims.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muramatsu et al. U.S. Patent No. 5,461,459 (hereinafter Muramatsu) in view of Applicant's Admitted Prior Art in the Background of the Specification pages 1-4 (hereinafter Admitted prior art).

5. With respect to claim 1, Muramatsu teaches a method of automatically laying out a print job for printing on a printer having a plurality of available media sizes, wherein the print job includes a designated print area, defined by the designated length and width of the finished printed output, the method comprising the steps of:

setting up the print job, the print job comprising data denoting the length and width of the finished output (length and width calculated and set up by CPU in fig. 16);

determining whether the print area is smaller than an available media size (col. 11, lines 26-41 and fig. 23);

determining whether the print area must be rotated to fit the print area on an available media size (col. 11, lines 26-41 and fig. 23);

automatically selecting a media size from the available media (col. 8, lines 43-45);

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automatically calculating the distance and direction the print area must be shifted to locate the print area on the media in such a manner as to optimize the image location on the media (col. 7, lines 38-48 & col. 13, lines 63-67);

printing the print job with the calculated image area shift and image area rotation (col. 5, lines 3-7).

It is apparent to one of ordinary skill in the art that the media size and the rotating value are determined by the determination steps of (b) and (c).

Muramatsu does not teach a method of enabling the printer to print full-bleed.

Admitted prior art teaches a method for setting up a print job, the print job comprising data denoting the length and width of the finished output (requesting to print on odd-size media in page 2, line 3) and a method of enabling the printer or copier to print full-bleed (page 1, line 20 & page 2, lines 25-26).

Muramatsu and Admitted prior art analogous art because they are from the same field of endeavor, that is the printing and copying art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the copier of Muramatsu to print full-bleed on a selected paper size.

The suggestion/motivation for the modification would have been to provide a full-bleed copier or printer that can automatically select a correct paper size and calculate the rotation and shift values. By doing so, it would have further fit the print area optically and reduced the burden for a user to manually input the rotation and shift values.

Therefore, it would have been obvious to combine Muramatsu with Admitted prior art to obtain the invention as specified in claim 1.

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6. With respect to claim 2, Muramatsu teaches that the printed output is single-sided (fig. 2).

7. With respect to claim 3, Muramatsu teaches that the printed output is double-sided (fig. 2).

8. With respect to claim 4, the combination of Muramatsu and Admitted prior art teaches the method of claim 1, wherein Admitted prior art further teaches that the printer is capable of full-bleed printing on four edges of the media (page 1, lines 19-20).

9. With respect to claim 5, the combination of Muramatsu and Admitted prior art teaches the method of claim 1, wherein Muramatsu teaches a method of shifting the print area to leave a margin for the binding (figs. 3 & 4). Since Admitted prior art teaches the method of printing an entire page with no unprinted margins, at the time of the invention, one would have been motivated to incorporate the shifting method of Muramatsu to leave a binding area for the binding in the full-bleed printed page. Thus, the combination of the combination of Muramatsu and Admitted prior art teaches the invention as specified in claim 5.

10. With respect to claim 6, the combination of Muramatsu and Admitted prior art teaches the method of claim 3, wherein Muramatsu teaches that the printer margin is on the leading edge (option of choosing the binding direction in figs. 3 & 4).

11. With respect to claim 7, the combination of Muramatsu and Admitted prior art teaches the method of claim 1, wherein Admitted prior art teaches the method further comprising a step of printing (writing down) an instruction sheet accompanying the print job that comprises instructions for setting up a post-printing trimming device (page 2, lines 16-19). Since it is well know to one of ordinary skill in the art that the printer can

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print any data inputted by the user, instead of manually writing down the instruction, one would have been motivated to print the instructions and notify/inform the person performing the trimming with the correct/proper trimming instruction to produce a proper/correct trimming function.

12. With respect to claim 9, the combination of Muramatsu and Admitted prior art teaches the method of claim 5, wherein Admitted prior art teaches that the printed output is single-sided (fig. 2). Since Admitted prior art teaches the method of printing an entire page with no unprinted margins, at the time of the invention, one would have been motivated to incorporate the single-sided margin shifting method of Muramatsu to leave a binding area on single-side printed page for the binding in the full-bleed printed page. Thus, the combination of the combination of Muramatsu and Admitted prior art teaches the invention as specified in claim 9.

13. With respect to claim 10, the combination of Muramatsu and Admitted prior art teaches the method of claim 5, wherein Admitted prior art teaches that the printed output is double-sided (fig. 2). Since Admitted prior art teaches the method of printing an entire page with no unprinted margins, at the time of the invention, one would have been motivated to incorporate the double-sided margin shifting method of Muramatsu to leave a binding area on double-side printed page for the binding in the full-bleed printed page. Thus, the combination of the combination of Muramatsu and Admitted prior art teaches the invention as specified in claim 10.

14. With respect to claim 11, Muramatsu teaches a method of automatically laying out a print job for printing on a printer having a plurality of available media sizes,



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wherein the print job includes a designated print area, defined by the designated length and width of the finished printed output, the method comprising the steps of:

- a. setting up the print job, the print job comprising data denoting the length and width of the finished output (length and width calculated and set up by CPU in fig. 16);
- b. determining whether the length of the print area is smaller than a leading edge of an available media size and that the width of the print area is smaller than a lateral edge of an available media size (col. 11, lines 26-41 and fig. 23);
- c. determining whether the length of the print area is smaller than the lateral edge of an available media size and whether the width of the print area is smaller than the trailing edge of an available media size (col. 11, lines 26-41 and fig. 23);
- d. determining whether the print area must be rotated to fit the print area on an available media size (col. 11, lines 26-41 and fig. 23);
- e. automatically selecting a media size from the available media (col. 8, lines 43-45);
- f. automatically calculating the distance and direction the print area must be shifted to locate the print area on the media in such a manner as to optimize the image location on the selected media (col. 7, lines 38-48 & col. 13, lines 63-67);
- g. printing the print job with the calculated image area shift and image area rotation (col. 5, lines 3-7).

It is apparent to one of ordinary skill in the art that the media size and the rotating value are determined by the determination steps of (b) and (c).

Muramatsu does not teach a method of enabling the printer to print full-bleed.

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Admitted prior art teaches a method for setting up a print job, the print job comprising data denoting the length and width of the finished output (requesting to print on odd-size media in page 2, line 3) and a method of enabling the printer or copier to print full-bleed (page 1, line 20 & page 2, lines 25-26).

Muramatsu and Admitted prior art analogous art because they are from the same field of endeavor, that is the printing and copying art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the copier of Muramatsu to print full-bleed on a selected paper size.

The suggestion/motivation for the modification would have been to provide a full-bleed copier or printer that can automatically select a correct paper size and calculate the rotation and shift values. By doing so, it would have further fit the print area optically and reduced the burden for a user to manually input the rotation and shift values.

Therefore, it would have been obvious to combine Muramatsu with Admitted prior art to obtain the invention as specified in claim 11.

15. With respect to claim 12, the combination of Muramatsu and Admitted prior art teaches the method of claim 11, wherein Admitted prior art further teaches that the printer is capable of full-bleed printing on four edges of the media (page 1, lines 19-20).

16. With respect to claim 13, the combination of Muramatsu and Admitted prior art teaches the method of claim 11, wherein Muramatsu teaches a method of shifting the print area to leave a margin for the binding (figs. 3 & 4). Since Admitted prior art teaches the method of printing an entire page with no unprinted margins, at the time of the invention, one would have been motivated to incorporate the shifting method of

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Muramatsu to leave a binding area for the binding in the full-bleed printed page. Thus, the combination of the combination of Muramatsu and Admitted prior art teaches the invention as specified in claim 13.

17. With respect to claim 14, the combination of Muramatsu and Admitted prior art teaches the method of claim 13, wherein Muramatsu teaches that the printer margin is on the leading edge (option of choosing the binding direction in figs. 3 & 4).

18. With respect to claim 15, the combination of Muramatsu and Admitted prior art teaches the method of claim 11, wherein Admitted prior art teaches the method further comprising a step of printing (writing down) an instruction sheet accompanying the print job that comprises instructions for setting up a post-printing trimming device (page 2, lines 16-19). At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the printing system to print any messages, such as instructions, instead of physically writing down the messages since this printing method using the printing system is well known in the art. Moreover, one would have been motivated to do so to notify/inform the person performing the trimming with the trimming instruction to produce a proper/correct trimming function.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Muramatsu and Admitted prior art as applied to claim 1 above, and further in view of Kubo et al. U.S. Patent No. 6,765,691 (hereinafter Kubo).

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19. With respect to claim 8, the combination of Muramatsu and Admitted prior art teaches the method of claim 1, but it does not teach expressly the method of sending a trimming instructions to a trimming device connected to the printer.

Kubo, the same field of endeavor of laying out a print job and printing the print job, teaches the method of sending trimming instructions to a trimming device connected to the printer (col. 23, line 62 – col. 24, line 7). The presence of trimming device is inherent since there is a trimming operation according to the instruction given by the user.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the method of sending trimming instruction to a trimming device with the full-bleed printer of Muramatsu and Admitted prior art as specified in claim 1.

The suggestion/motivation for doing so would have been to automatically instruct the trimming device with the exact instructions given by the user desires to trim the printed paper.

Therefore, it would have been obvious to one of ordinary skill in the art to combine the three references to obtain the invention as specified in claim 8.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Muramatsu and Admitted prior art as applied to claim 11 above, and further in view of Kubo.

20. With respect to claim 16, the combination of Muramatsu and Admitted prior art teaches the method of claim 11, but it does not teach expressly the method of sending a trimming instructions to a trimming device connected to the printer.

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Kubo, the same field of endeavor of laying out a print job and printing the print job, teaches the method of sending trimming instructions to a trimming device connected to the printer (col. 23, line 62 – col. 24, line 7). The presence of trimming device is inherent since there is a trimming operation according to the instruction given by the user.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the method of sending trimming instruction to a trimming device with the full-bleed printer of Muramatsu and Admitted prior art as specified in claim 11.

The suggestion/motivation for doing so would have been to automatically instruct the trimming device with the exact instructions given by the user desires to trim the printed paper.

Therefore, it would have been obvious to one of ordinary skill in the art to combine the three references to obtain the invention as specified in claim 16.

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**Conclusion**

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
August 28, 2004

Chan S. Park  
Examiner  
Art Unit 2622

EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600  
SUPERVISORY PATENT EXAMINER  
EDWARD COLES